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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,059	04/12/2001	Yong Lung Wei	514-039-11	5262

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EXAMINER

FOSTER, JIMMY G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,059

Applicant(s)

Wei

Examiner

Jimmy G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. The original patent has not been surrendered. Applicant is reminded that this reissue application will not be allowed until the original patent is actually surrendered.

2. Claims 1 and 3-16 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. This reissue has corrected errors which were not addressed in the original declaration.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

3. The affidavit of Kailash C. Vasudeva filed on May 23, 2002, has been considered by the examiner. Although the affidavit effectively states that the tool box of Wei (the inventor) in U.S. Patent No. 5,893,457 (the patent in reissue) was subject to obligation of assignment at the time the invention (of Wei) was developed/made, the affidavit fails to clearly conclude that both the subject matter of prior art

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patent 5,803,254 (Vasudeva) and of the claimed invention (5,893,457 Wei) were commonly owned (or with obligation for assignment to Maxtech) at the time the invention (of 5,893,457) was made. If Assignee can correctly make this statement, a supplemental affidavit should be filed with such a statement if Applicant desires to remove the Vasudeva reference as "prior art" under 35 U.S.C. 103. (It might be wise to make such declared statements for all of the similar Vasudeva references cited in this application in order to compact the prosecution time for this reissue.)

Applicant will note that even if the Vasudeva reference (5,803,254) is removed as prior art with respect to 35 U.S.C. 103, it is not removed as prior art with respect to 35 U.S.C. 102. See MPEP 2146.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification includes an **inadequate written description** of the invention inasmuch as the invention set forth in claim 1 (and dependent claims thereof) is inaccurate with respect to the invention described in the DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT of the specification and the invention shown in the drawings. More specifically, claim 1

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inaccurately calls for the sliding plates (17) to be slidably disposed to the two side walls (12,12). While the detailed description of the specification discloses one sliding plate 17 as being slidably disposed with respect to one side wall 12, it discloses the other sliding plate 17 as being slidably disposed with respect to the separating board 11 (col. 2, lines 17-28), which is not a side wall within the meaning of Applicant's disclosure. In agreement with the detailed description, the drawings (see Figure 2) show that only one of the side walls 12 has a sliding plate 17 positioned adjacent thereto; the other does not.

Moreover, the SUMMARY OF THE INVENTION, like the claims, inaccurately calls for the sliding plates to be slidably disposed to the two side walls and therefore fails to summarize the invention that is described in the DESCRIPTION OF THE PREFERRED EMBODIMENTS and that is shown in the drawings.

Regarding claim 9 and dependent claims, **new matter** is claimed in the limitation, "at least one sliding plate" in claim 9 since the original disclosure did not consider, suggest or disclose the use of only one sliding plate for connection to the receiving members. Throughout the original disclosure it has been consistently disclosed that two sliding plates connect the receiving members to each other and connect the receiving members to the actuating member. Even in connection with the top receiving members, there are effectively disclosed two sliding plates, even though one of the plates (170) is called an "auxiliary plate." The auxiliary plate, described in the same paragraph of the specification as the sliding plates 17, is

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effectively a sliding plate since it slides over the separating board in substantially the same manner as one of the sliding plates 17. New matter may exist by virtue of the omission of a feature. See United States Industrial Chemicals, Inc v. Carbide and Carbon Chemicals Corp., 315 US 668, 53 USPQ 6 (1942). Also see MPEP 1411.02. In addition, it has been held that claims may be made no broader than the supporting original disclosure. The Gentry Gallery Inc v. The Berkline Corp., 45 USPQ2d 1498 (Fed. Cir. 1998). Accordingly claims 9-16 include new matter.

5. Claims 6, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 is indefinite as depending from a canceled claim 2. Claim 7 is indefinite because it depends from claim 6 which depends from a canceled claim 2. Applicant's remarks have included a statement that the dependency of claim 6 has been amended, but this is not correct.

Claim 11 calls for a first wall and "the other wall", but claim 11 (being dependent from claim 9) has three walls claimed, which include two parallel walls and also a back wall. Therefore, the limitation to "the other wall" is indefinite since it is unclear which other wall is being referred to by the limitation.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Vasudeva (5,803,254). Main box portion 1 and lid 3 of the tool case of Vasudeva together may be considered to define a base portion. In the orientation shown in Figures 7 and 8, the base portion includes a top (where the handle is) and a bottom (nearest the "FIG.7" or "FIG.8" designation, and a back wall (on the right side of the figure). Base portion 1,3 also includes a recess 15. The recess 15, in turn, includes that includes a back wall and parallel side walls (unnumbered) which extend from the back wall. Accordingly, the base portion which includes the recess may be considered to include the back wall and the parallel side walls. At least one of the side walls of recess 15 defines a side wall of the base portion insofar as Applicant has claimed since Applicant does not require that the side wall delineate an interior of the base portion from the exterior of the base portion and since the term "side wall" may refer to an interior side wall. Alternatively, the recess 15 itself may be considered to be the base portion (instead of all

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of elements 1,3) since it acts as a base for the containers 16 placed therein.

Within the base portion 1,3 and the recess 15 thereof, the storage containers 16 are pivotally connected/mounted to said side walls at the connection of the pins 25 (on the containers) with the female connection means 26 (in the side walls). The storage containers 16 define receiving members since they have interiors designed to receive contents.

The receiving members/storage containers 16 are also pivotally connected/mounted to the slidable plates/gang bars 30, wherein the male connections 31 engage the female openings 32. The slidable plates slide with respect to said side walls. When this happens, the receiving member/containers 16 pivot as a group toward an open position or toward a closed position. See the difference between Figures 7 and 8.

Any one of the receiving members/containers 16 is capable of being manually manipulated to pivot that container and induce pivotal movement of the other containers at the same time. Accordingly, any one of the containers may also be considered to reasonably define an actuating member since it can be used to actuate the other containers.

As shown in Figure 9, a centrally located one of said recess side walls defines a separating board, which will function to separate the recess from the remainder of the tool case. A portion of this wall/board is shown extending toward the handle and away from the recess in the figure. Therefore, insofar as Applicant has claimed, this extending portion of Vasudeva extends further away from the other side wall (of the

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recess) than the remainder of the central side wall/board. In addition, another portion of said separating board is the interior slot projections 46, which may be considered to be considered to include a portion at a greater distance away from the other side wall than the remainder of the separating board.

Said separating board of Vasudeva is located between the side walls of the main box 1, further regarding Applicant's claim 14. separates the receptacle portion that holds the six receiving member containers 16, from the remainder of the container which includes the storage section dividers 45.

Further regarding Applicant's claims 13 and 16, the receiving members/containers 16 of Vasudeva have a plurality of receiving recesses insofar as Applicant has claimed since each one includes one recess and since there are plural receiving members.

8. Claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard (4,531,646). The reference of Howard discloses a product display rack with tiltable tray and insert assemblies 20,32. The rack frame 12 includes a back/rear wall 13 and side members/walls 14,15. The side walls may be considered to further include members 26. A header assembly 16 defines a top, and the base 18 defines a bottom. This combination defines a box.

The box of Howard is inherently capable of holding tools of appropriate size, and such a capability meets the limitation, "tool box" claimed by Applicant.

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Insofar as claimed by Applicant, one of the walls 14,26 or 15,26 may be considered to define a separating board inasmuch as it would separate the interior of the frame from the exterior of the frame. The portion 26 of the separating board is at a lesser distance from the other wall than is the remainder of the separating board.

The tray assemblies 20,32 define receiving members since they include channeled recesses between partitions 31 for receiving articles or packages therein. Opposite ends of the front portions of said receiving members 20,32 are pivotally attached to the members 26 which are fixed on the side walls 14,15.

Defining sliding plates are the members 24 which slide with respect to the side walls 14,15. The opposite ends of the rear portions of said receiving members are pivotally attached to said sliding plates 24. The attachment interconnects the rear portions so that the receiving members will simultaneously tilt and so that actuation of one receiving member 20,32 will automatically result in similar movement from other receiving members (col. 2, lines 62-67). Accordingly, any of the receiving members can be also defined as an actuating member.

Further regarding Applicant's claim 14 which calls for one of the walls to be located between side walls, wall 18 and the header 16 may be considered to define side walls insofar as Applicant has claimed. The walls 14 and 15 are disposed between said side walls 16,18.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13 and 16 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Vasudeva (5,803,254) in view of Sidabras et al (5,570,784). The reference of Sidabras et al at 42 and at Figure 1 suggests that a tool receiving member may be provided with plural recesses for the purpose of positioning the tools in an orderly manner. Accordingly, it would have been obvious in view of Sidabras et al to have provided the receiving members 16 of Vasudeva each with plural recesses for the purpose of positioning tools in an orderly manner in the receiving members.

11. Claims 3-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, upon the filing of an appropriate supplemental reissue declaration.

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12. Applicant's arguments filed April 24, 2002 and May 23, 2002 have been fully considered but they are not persuasive. Applicant has apparently argued that in view of the affidavit to Vasudeva, the patent to Vasudeva (5,803,254; the supplemental response incorrectly referred to the present patent 5,893,457 under reissue as being the prior art reference) should be removed as a applied prior art. The examiner answers that the affidavit is insufficient in its statements to remove patent 5,803,254 as a reference under 35 U.S.C. 103, and the affidavit is ineffective to remove the reference under 35 U.S.C. 102(e).

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Regarding the new matter rejection of claims 9-16, Applicant has argued that the drawings suggest the use of only one sliding plate between some of the receiving members. The examiner disagrees since the auxiliary members 170 are also effectively sliding members.

13. Applicant's arguments regarding rejections involving the references of Loomis, Bond are moot in view of the withdrawal of the rejection because of the amendment to claim 9.

14. This action is **not** made final in view of the new grounds of rejection applied to certain claims under 35 U.S.C. 102 over the newly discovered patent to Howard, and in view of the new grounds of rejection of claims 1 and 3-8 under 35 U.S.C. 112, first paragraph, which rejections were not necessitated by Applicant's response.

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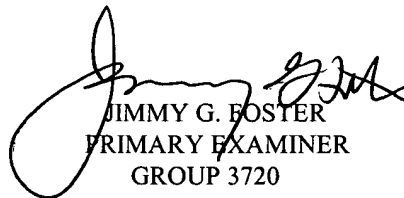
15. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --
Customer Service. . . (703)306-5648

For matters regarding examination -- Examiner:
Jim Foster (703)308-1505

For faxing of correspondence:
Draft amendments only-(703)308-7769
(Examiner should be notified of fax)
Formal correspondence-(703)305-3579 or 305-3580

For petitions:
Before the Examiner . (703)308-1505
Before the Director . (703)308-3872
Other petitions . . . (703)305-9282


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